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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,818	04/21/2004	Markus Eibl	24371/1	7282
7590 10/01/2007				
Thomas M. Saunders		EXAMINER		
Brown Rudnick Berlack Israels LLP		KEMMERLE III, RUSSELL J		
Box IP		ART UNIT		
One Financial Center		PAPER NUMBER		
Boston, MA 02111		1731		
			MAIL DATE	DELIVERY MODE
			10/01/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/828,818

**Applicant(s)**

EIBL, MARKUS

**Examiner**

Russell J. Kemmerle

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 102/103***

Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hampl (US Patent 4,739,775).

Hampl teaches a cigarette with an increased self-extinguishing tendency having at least two annular zones of polyvinyl acetate (Fig 4; Col 4 lines 55-68). Polyvinyl acetate has an interfacial tension of  $36.5 \text{ mJ/m}^2$  (applicant's current specification, page 2 lines 17-18).

Claims 7-10 are rejected under 35 U.S.C. 102(b) as anticipated by Hampl or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hampl in view of Molins (US Patent 1,757,380) and Ashcraft (US Published Application 2003/0,131,860).

Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hampl in view of Molins and Ashcraft.

Referring to claim 7, the strips of polymer on the cigarette paper taught by Hampl meet the limitation of an "incorporated polymer" which does not require that the polymer be in the paper, but only that it be part of the whole of the paper, which would include being on the surface of the paper.

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Referring to claim 4, and to claims 7-10 in the alternative (in case it is found that the "incorporated polymer" is required to be in the paper), Hampl is relied upon as discussed above.

Molins teaches that the intaglio printing process is known in the cigarette paper art (Col 2 lines 50-55).

Ashcraft teaches that ethanol is an exemplary organic solvent for use with polyvinyl acetate, the polymer of Hampl, when printing such a polymer on a cigarette paper (Page 9, paragraph 68).

It would have been obvious to one of ordinary skill in the art, at the time of invention by applicant to have modified the process taught by Hampl by using the intaglio printing process taught by Molins. This would have been obvious because Hampl teaches that various means may be used to apply the annular zones to the paper (Col 4 lines 55-68), and the intaglio process taught by Molins is one of such means known in the art. It would have been further obvious to one skilled in the art that when using the polyvinyl acetate of Hampl to also use ethanol, which Ashcraft teaches is an exemplary solvent for polyvinyl acetate.

Because the processes as recited by current claims 4 and 6 are found to be obvious over Hampl in view of Molins and Ashcraft, it is assumed that the result (i.e., that the polymer penetrates for the predominant part into the paper) would occur as recited by the current specification.

***Response to Arguments***

Applicant's arguments filed 26 July 2007 have been fully considered but they are not persuasive.

Applicant argues that Hampl fails to anticipate claims 1-3, 5 and 6-10 because Hampl does not disclose polymer in the cigarette paper. However, these claims do not require the polymer to be in the paper. For example, claim 1 reads in part "annular zones whose porosity is reduced by the presence of a polymer". All that is required is that a polymer be present, as is taught by Hampl, there is no requirement that the polymer of those claims be in the paper.

Applicant argues that the assumption that the predominant part of the polymer would penetrate into the cigarette paper is unsupported speculation by the Examiner. This assumption is in fact supported by the applicant's current specification. The combination of Hampl, Molins and Ashcraft is found to make obvious the process recited by the applicant; it is assumed that the result (i.e., that the polymer penetrates for the predominant part into the paper) would occur as taught by the applicant and discussed above. Because this is the basis of the rejection, and not the personal knowledge of the Examiner, an affidavit under 37 CFR 104(d)(2) would not be appropriate.

Applicant argues that none of the references teach the interfacial tension recited in the claims. However, Hampl discloses the use of Polyvinyl acetate as the polymer used, which applicant admits in the specification meets the interfacial tension requirements of all claims that recite such a limitation.

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***Conclusion***

Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell J. Kemmerle whose telephone number is 571-272-6509. The examiner can normally be reached on Monday through Friday, 8:30-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RJK/

  
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